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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,401	08/27/2001	Francois Marquis	33904	4354

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EXAMINER

FAULK, DEVONA E

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,401

Applicant(s)

MARQUIS ET AL.

Examiner

Devona E. Faulk

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

By

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 8** is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a wireless transmitter, does not reasonably provide enablement for how a DTMF signal as the encoded audio signal is used to control the decoder unit so that it produces a control signal that is input to the generator and how the transmitter generates a signal as a result of the DTMF signal. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification only discloses on page 7, lines 1-2 that in a preferred embodiment the encoded audio signal is formed by dual-tone multi-frequency encoded audio signal. The only other mention of a DTMF signal is in claim 9. The specification discloses, on page 10, lines 20-27) that the audio signal input tab T9 may be connected to an audio source of either an external microphone, an audio output of an internet connection device, of an audio player as in a CD, MP3 tape or DVD player. There is no disclosure as to where a DTMF signal would come from or how it would be used as claimed.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2644

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 9** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites, "wherein said audio signal to control signal decoder receives an encoded audio signal". It is not clear what is meant by an audio signal receiving an audio signal and furthermore the specification only recites "under audio signals in the frequency range of 100 Hz to 20KHz" (page 4, lines 6-7) and "thereby the addressed audio signals are within the frequency range of 100 Hz to 20KHz" (page 7, lines 5-6). The examiner has interpreted the claim to mean that the decoder receives an encoded audio signal in the range of 100 Hz to 20KHz.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-6, 10-13** are rejected under 35 U.S.C. 102(b) as being anticipated by McGreevy (US 5,319,716).

Regarding claim 1, McGreevy discloses a wireless transmitter (Figure 1) comprising:

an antenna (52, figure 1);

a transmitter signal generator unit generating a signal to be transmitted to an output and having a control input, a control signal applied to said control input controlling at least one of a frequency band, wherein at least one carrier frequency of said signal to be transmitted resides, and of a power level of said signal to be transmitted (BA 1404; column 2, lines 18-36; column 2, lines 35-38 and 58-60);

said output of said generator unit being connected to an antenna (figure 1);

an audio signal (signal from CD player, column 1, lines 52-55) to control a signal decoder unit (compressor circuit, 10 and 12; one synonym of decode is to alter or change and compressor serves to alter the signal); said decoder unit generating a control signal at an output of said decoder unit in response to an encoded audio signal at an input of said decoder unit (figure 1);

said output of said decoder unit being operationally connected to said control input of said generator unit (figure 1).

Regarding **claim 2**, McGreevy further discloses said input of said decoder unit being operationally connected to at least one audio signal input tab (left and right inputs) of said wireless transmitter (column 1, lines 52-55).

Regarding **claim 3**, McGreevy further discloses said input tab being connectable to at least one external audio signal source (column 1, lines 52-55; column 2, lines 39-41).

Regarding **claim 4**, McGreevy further discloses and wherein said audio signal source is at least one of a microphone, an audio player and an internet connection device (column 1, lines 52-55; column 2, lines 39-41).

Regarding **claim 5**, McGreevy further discloses wherein said generator unit comprises a modulator unit (16 and 16') with a carrier frequency signal input (36, Figure 1) and an output being operationally connected to said output of said generator unit (Figure 1) and having a modulation input, said modulation input being operationally connected to said input for said encoded audio signal (Figure 1).

Regarding **claim 6**, McGreevy further discloses wherein said generator unit generating said signal to be transmitted as an amplitude-modulated signal, a frequency-modulated signal, a phase-modulated signal or a modulated pulse signal (abstract).

Regarding **claim 10**, McGreevy further discloses wherein said frequency band comprises more than one carrier frequency of said signal to be transmitted (inherent; column 3, lines 2-7).

Regarding **claim 11**, McGreevy further discloses a manually operable selection unit with an output operationally connected to a control input of a carrier frequency generator unit, said control input controlling selection of the carrier frequency of said signal to be transmitted, out of said more than one carrier frequency (manually controllable reactive components 54, Figure 1; column 3, lines 2-7).

Regarding **claim 12**, McGreevy further discloses wherein said encoded audio signal defining more than one carrier frequency in said frequency band (inherent; column 3, lines 2-7).

Regarding **claim 13**, McGreevy discloses a hearing system (wireless compact disc stereo playback system) comprising:

An ear device (sound system of vehicle) with an output electrical to mechanical converter (vehicle speakers inherent; column 2, lines 10-11) and with a wireless receiver (FM radio, antenna/receiver of automobile), the output thereof being operationally connected to said electrical to mechanical converter (column 2, lines 10,11; inherent);

A wireless transmitter (Figure 1) according to one of the claims 1 to 12(See above apropos rejection of claim 1), a signal transmitted from said wireless transmitter being received and demodulated at said ear device and acting on said electrical to mechanical converter (Figure 1; column 2, lines 2-11; column 3, lines 8-18).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over McGreevy (US 5,319,716) in view of Koike (US 6,778,814).

Regarding **claim 7**, McGreevy fails to disclose but Koike teaches of wireless transmitter further comprising at least one microphone, an output thereof being

operationally connected to said input of said decoder unit (Figure 2). It would have been obvious to modify McGreevy by incorporating a microphone in order to provide the capability of wirelessly transmitted voice signals.

9. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over McGreevy (US 5,319,716).

Regarding **claim 9**, McGreevy fails to disclose wherein said audio signal to control signal decoder receives an encoded audio signal in a frequency range of 100 Hz to 20 kHz. It is well known in the art that CD player can supply music within the claimed range. It would have been obvious to modify McGreevy so that the audio signals supplied are in range of 100Hz to 20Khz in order to be able to process signals from the CD source.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devona E. Faulk whose telephone number is 571-272-7515. The examiner can normally be reached on 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEF


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